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| APPLICATION NO.                                 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/540,143                                      | 06/21/2005  | Makoto Katsumata     | 050396              | 3589             |
| 23850   | 7590        | 08/14/2006           | EXAMINER            |                  |
| ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP |             |                      | MAYO III, WILLIAM H |                  |
| 1725 K STREET, NW                               |             |                      | ART UNIT            |                  |
| SUITE 1000                                      |             |                      | PAPER NUMBER        |                  |
| WASHINGTON, DC 20006                            |             |                      | 2831                |                  |

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/540,143

Applicant(s)

KATSUMATA ET AL.

Examiner

William H. Mayo III

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2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on June 20, 2006. These drawings are approved.

### ***Response to Amendment***

2. The applicant appears to add new claims 5-8, however the applicant previously submitted an amendment which included claims 1-5. Therefore the newly submitted claims have been renumbered as claims 6-9 as instructed under Rule 1.126 and a rejection of claims 1-9 follows below.

### ***Election/Restrictions***

3. Newly submitted claims 6-9 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Specifically, Inventions II and I (i.e. claims 1-5 & claims 6-9, respectively) are related as combination and subcombination. Inventions I & II in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the electrical cable may comprise first and second marks that are applied in a circumferential direction as opposed to a lateral direction as claimed. The

subcombination has separate utility such as an wiring harness in an automobile as opposed to an electrical cable in a cable cutting insulation.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 6-9 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Masuda et al (JP Pat Num 06-190315, herein referred to as Masuda). Masudo discloses an electrical cable (Figs 1-11) having a conductor core (3) and a sheathing layer (not number) covering the core (3), wherein the sheathing layer (not numbered) is made by a synthetic material having an outer surface with a mono color (paragraph 7), wherein the freedom of marking and lay out of the cable can be improved (see abstract under purpose). Specifically, with respect to claim 1, Masudo discloses an electrical cable (Figs 9 & 11) comprising a first mark (M1) having a first color and provided on a first part (left end) of an outer surface of the sheathing layer (not numbered), and a second mark (M2) having a second color (paragraph 9) and provided on a second part (right end) of

the outer surface of the sheathing layer (not numbered), wherein the second color is provided by an ink feeder (10<sub>2</sub>) that is a different from a first color which is provided by a second ink feeder (10<sub>1</sub>, paragraph 9), wherein the second part (right end) is positioned on a opposite side of the first side (left end) in a lateral direction of the cable (Fig 9), wherein the first mark (M1) different than the second mark (M2) in a longitudinal direction of the cable (Fig 9b), wherein the sheathing layer (not shown) of the cable (6) has a first outer surface (outer surface of the left end) and a second outer surface (outer surface of right end), wherein the first and second outer surface (outer surface of the right and left ends, respectively), each extending in a longitudinal direction of the cable (Fig 12), wherein the first outer surface (outer surface of the left end) is positioned oppositely to the second outer surface (outer surface of the right end) in a lateral direction of the cable (Fig 9), wherein the first and second outer surfaces (outer surfaces of the left and right ends) are provided with a plurality of first and second marks (M1 & M2) that are alternately positioned (Fig 9) in a longitudinal direction. With respect to claim 2, Masudo discloses that the first mark (M1) and the second mark (M2) are positioned at an end of the cable (Fig 9b). With respect to claim 4-5, Masudo discloses that the sheathing layer (not numbered) of the cable (Fig 11) has a first outer surface (outer surface of the left end) and a second outer surface (outer surface of right end), wherein the first and second outer surface (outer surface of the right and left ends, respectively), each extending in a longitudinal direction of the cable (Fig 12), wherein the first outer surface (outer surface of the left end) is positioned oppositely to the second outer surface (outer surface of the right end) in a circumferential direction of the

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cable (Fig 11) with regular intervals (Fig 9b & 11, both shown the ink deposit nozzles being on opposite sides with respect to a circumferential direction) and wherein the first and second outer surfaces (outer surfaces of the left and right ends) are provided with a plurality of first and second marks (M1 & M2, respectively) that are alternately positioned (Fig 9b).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Communication***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
William H. Mayo III  
Primary Examiner  
Art Unit 2831

WHM III

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March 27, 2006





Approved  
8/5/06

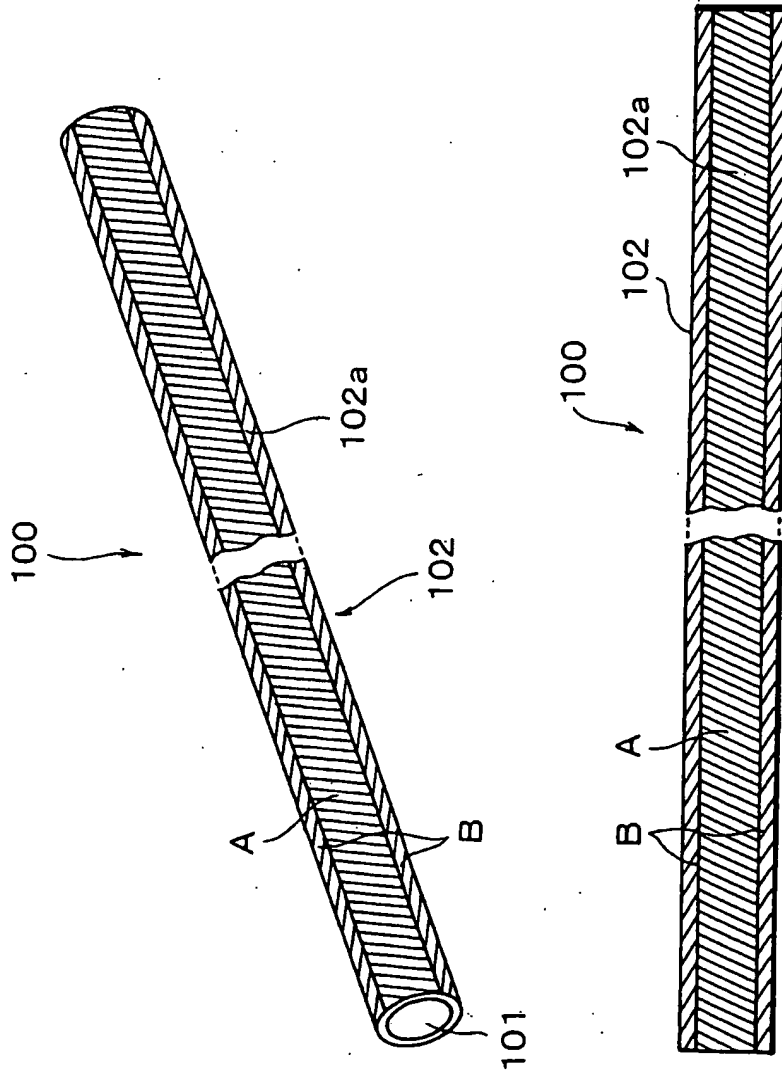


FIG. 9A

PRIOR ART

FIG. 9B

PRIOR ART